

REMARKS

This application pertains to a novel process for preparing UV-transparent pressure-sensitive adhesives, having a UV transparency at 300 nm of more than 95%. In the process, an acrylic copolymer composition is formed having a weight average molecular weight of less than 300,000 g/mol, and from 2 to 20% by weight of a silicate filler having a maximum particle diameter of 50 nm is mixed into the copolymer composition.

Applicants have discovered that, by keeping the weight average molecular weight of the copolymer composition at less than 300,000 g/mol and the maximum particle diameter of the silicate filler at 50 nm, the UV transparency at 300 nm of the composition is more than 95% (page 1, last paragraph) and the difficulties encountered by the prior art are avoided. Specifically, in the prior art, the inclusion of fillers in the adhesives resulted in adhesives having relatively low cohesion, since the fillers reduced the transparency and interfered with UV cross-linking (see the discussion of Reference Example 3 on page 17). On the other hand, the complete absence of fillers also resulted in low cohesion of low molecular weight adhesives. See the discussion of Examples 1-4 vs. Reference Examples 1 and 2 in the paragraph following Table 1 on page 17.

The present invention overcomes the deficiencies of the prior art adhesive compositions.

Claims 1 to 9 are pending.

Claims 1-8 stand rejected under 35 U.S.C. 103(a) as obvious over Husemann et al (US 6,720,399) or Husemann et al (US 6,958,186).

As Applicants have previously pointed out, they are the Applicants of the Husemann et al (US 6,720,399) patent as well as of the present application. The Husemann et al (US 6,720,399) patent is therefore not "a patent granted on an application for patent by another...", as is required by 35 U.S.C. 102(e). It is therefore difficult to understand the Examiner's insistence that this reference is available under 35 U.S.C. 102(e). Applicants respectfully disagree, and once again suggest to the Examiner that this reference is not available under 35 U.S.C. 102(e) against the present application.

However, in view of the Examiner's insistence that the reference is available, Applicants also respectfully point out that there is absolutely nothing in this reference that would teach or suggest that a UV transparency at 300 nm of more than 95% would be possible in a polyacrylate adhesive having a silicate filler content of 2 - 20% by weight. Applicants have discovered that this can be achieved by keeping the molecular weight of the polymer at less than 300,000 and by using silicate fillers having maximum particle diameters of 50 nm.

All that is shown in the '399 reference concerning fillers is that they may be present (col. 3, lines 57-60; col 9, lines 15-19). Absolutely nothing is taught or suggested about how fillers can be added while at the same time maintaining a UV transparency of 95%. A 95% transparency means that the fillers Applicants add have almost no effect on UV transparency ! This is truly surprising; no person skilled in the art would have thought this possible.

Similarly, all Husemann '186 teaches about fillers is that it is possible to include a filler in the polyacrylate PSA (col. 13, lines 61-64). Nowhere, however, does this reference teach or suggest anything about how a filler can be added while at the same time maintaining a UV transparency of 95%, nor does this reference disclose anything at all about filler technology. How is anyone reading this reference ever going to arrive at the proposition of keeping the molecular weight of a polyacrylate copolymer below 300,000 and adding from 2-20% Wt. of a silicate filler having a maximum diameter of 50 nm to achieve a UV transparency of 95% in the resulting PSA?

The Examiner contends that "The level of skill in this art is such that an artisan would know how to manipulate the silicates, both in constitutional limitations as well as particle size, to produce transparent articles." Prior art is not established by such a proclamation, however; evidence is needed! It should also be pointed out that Applicants' claims relate to UV transparency, not just "transparency". The Examiner has not provided one shred of evidence to show that those skilled in the art would know to "manipulate" (or how to do so) the amount and size of silica particles to achieve a UV transparency of 95%, while still having a minimum of 2% of the filler in the adhesive.

The question to be asked is whether those skilled in the art, reading either the Husemann '399 reference or the Husemann '186 reference would ever be led to form a copolymer composition of components a1 - a4, of Applicants' main claim, keep the molecular weight of said copolymer at less than 300,000 g/mol and mix 2 to 20% by weight of a silicate filler having a maximum particle diameter of 50 nm, to

form a PSA having a UV transparency at 300 nm of more than 95%. The answer is clearly a resounding NO, as none of the recited elements can be found in either of the references, and nothing can be found in either of the references that would suggest the changes that would be necessary to arrive at the process recited in Applicants' claims.

The rejection of 1-8 under 35 U.S.C. 103(a) as obvious over Husemann et al (US 6,720,399) or Husemann et al (US 6,958,186) should therefore now be withdrawn.

The provisional obviousness-type double patenting rejection of claims 1-9 over claims 1-8 of copending application No. 10/745,305 is obviated by the accompanying Terminal Disclaimer.

In view of the present remarks, it is believed that claims 1-9 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested, and the allowance thereof is courteously solicited.


#### CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

#### ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

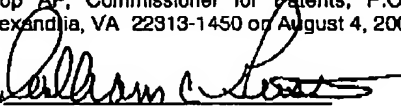
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